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1385.45508X00 (P-5803)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Andrea LIEBMANN-VINSON, et al.
Serial No.: 10/662,640
Filed: September 15, 2003
For: HIGH THROUGHPUT METHOD TO IDENTIFY LIGANDS FOR CELL
ATTACHMENT
Group: 1631
Examiner: MILLER, Marina I.
Conf. 9402

PETITION TO WITHDRAW RESTRICTION REQUIREMENT

Mail Stop: Amendment
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

May 1, 2006

Sir:

Responsive to the Communication dated February 28, 2006, Applicants respectfully petition the Director for withdrawal of the outstanding Restriction Requirement. For the reasons set forth herein, Applicants respectfully submit that the requirement to elect is improper at this time.

Applicants canceled claims 4, 8-10, and 15 by Preliminary Amendment dated September 29, 2005. Claim 1 is independent and the remaining claims (1-3, 5-7, 11-14 and 16-19) depend from independent claim 1.

The Communication indicates that claim 1 is generic, but insists on the requirement that Applicants elect from the following:

- A) Agents: (as recited in claim 8);
- B) Data acquisition (as recited in claim 9);
- C) Biological response (as recited in claim 10);

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- D) Statistical design (as recited in claim 15); and
- E) Agent-immobilizing material (as recited in claim 4).

Applicants respectfully point out that the claims upon which the restriction requirement is based are no longer pending in the Application. More particularly, there are no species claims presently pending in the application. Accordingly, there are no grounds upon which such a restriction can be based. The MPEP further states that "no restriction can be required except in those applications where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary." The presently pending claims clearly do not recite such a "multiplicity" of species. Furthermore, the Office Action has not indicated how such an alleged multiplicity would require an unduly extensive and burdensome search.


The mere fact that the disclosure can support claims of different species is not a ground for issuing a Restriction Requirement that necessarily requires an election of canceled claims, regardless of whether or not (some of) these claims were previously directed to different species. Applicants further submit that a Restriction Requirement would only be proper if, and when, claims directed to additional species are added to the application. Until such a time, however, Applicants would be forced to elect claims that are no longer pending in the application.

For all the foregoing reasons, Applicants respectfully submit that the outstanding Restriction Requirement is improper and request withdrawal thereof.

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Applicants request any shortage or excess in fees in connection with the filing of this paper, including extension of time fees, and for which no other form of payment is offered, be charged or credited to Deposit Account No. 01-2135 (Case: 1385.45508X00).

Respectfully submitted,
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LDT/vvr

Dated: May 1, 2006